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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,748

10/06/2006

Joseph R. Garlich

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3652

27148

7590

06/23/2008

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EXAMINER

RAE, CHARLESWORTH E

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,748	Applicant(s) GARLICH ET AL.	
	Examiner CHARLESWORTH RAE	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/06/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response without traverse, received 04/09/08, to the restriction/election requirements, mailed 01/10/08, electing invention II (claims 5-6) and SF1740 (i.e. where R1 is $\text{NHCOCH}_2\text{OPh}$; see specification, paras. 0183-0185, including Table 26) as the compound species and heart disease as the disease species, is acknowledged.

Applicant's preliminary claim amendment, filed 4/9/08, is also acknowledged.

Status of the Claims

Claims 1-12 are currently pending in this application.

Claims 1-4, and 7-12 are withdrawn for being directed to non-elected subject matter.

Claims 5 and 6 are presented for examination.

Restriction/Election

The restriction/election requirements mailed 4/9/08 are made final.

Claim of Benefit

Receipt of applicant's priority documents (US Provisional Applications 60/559,802, 60/590,043, and 60/625,871) are acknowledged. A review of US Provisional Applications 60/559,802 and 60/590,043 failed to reveal any disclosure to support applicant's elected species. For examination purposes, the effective filing date for the instant application is deemed to be 11/08/04, the filing date of the priority provisional application 60/625,871 (see pages 15, and 20-21).

Claim rejections – 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

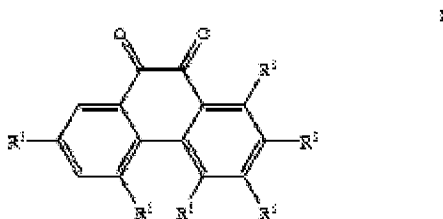
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

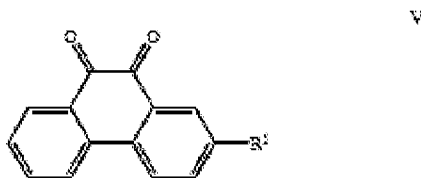
Claims 5 and 6 are rejected under 103(a) as being unpatentable over Chapdelaine et al. (US Patent Application Pub. No. 2003/0207812 A1).

Chapdelaine et al. (US Patent Application Pub. No. 2003/0207812 A1) teach substituted phenanthrene-9, 10-dione compounds having the below structures (see paras. 0008 and 0023):

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[0008] wherein R^2 at each occurrence is independently selected from hydrogen, halogen, NH_2 , NO_2 , $NH-CO-R^2$, $CO-NH-R^2$, Ar, $(CH_2)_nCH(COOH)R^3$, COR^3 , $NHCOCH_2CH(COOH)NHR^4$ and $N(R^4)_2$.



[0023] wherein R^1 is $NHCOCH_2CH(COOH)NHR^4$, where R^4 is a C-linked N-acetyl-oligopeptide selected from Q, EGQ, ATEGQ, TATEGQ, and FTATEGQ.

Applicant's elected compound overlaps with the above referenced formula

V, when reference R1 is NH-CO-R2. However, Chapdelaine et al. do not teach applicant's elected compound species (i.e. wherein R1 = NH-COCH₂OPh).

Chapdelaine et al. also teach compositions and methods of treatment comprising administering said compounds for treating immunologically related diseases and disorders (see paras. 0002-0007). Although the instant claims differ from the reference by reciting a specific species and a more limited genus than the reference, it would have been obvious to one of ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims, because an ordinary artisan would have reasonable expectation that any of the species

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of the genus would have similar properties and, thus, the same use as the genus as a whole.

Relevant Art of Record

The below cited art made of record and relied upon is considered pertinent to applicant's invention and is cited to show the general state of the art regarding the therapeutic utility of PTEN inhibitors.

Durden (US Patent 6,777,439) teaches PTEN inhibitors and methods of using said compounds for treating aberrant angiogenesis associated with several diseases, including cancer, autoimmune diseases, coronary artery diseases, and atherosclerosis (col. 2, lines 44-54).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12 June 2008

/C. R./

Examiner, Art Unit 1611

/Brian-Yong S Kwon/

Primary Examiner, Art Unit 1614